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OFFICE OF PETITIONS

In re Application of :
VAN DER GIESSEN et al. :
Application No. 10/533,135 :
Filed: 11/18/2005 :
Attorney Docket No. 066511.0111 :

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed January 23, 2008, to revive the above-identified application.

The petition under 37 CFR 1.137(a) is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within **TWO (2) MONTHS** from the mail date of this decision. The reconsideration request should include a cover letter entitled "Renewed Petition under 37 CFR 1.137(a)." Extensions of time under 37 CFR 1.136(a) are permitted. No additional fee is required for filing a "Renewed Petition under 37 CFR 1.137(a)."

The application became abandoned for failure to reply in a timely manner to the nonfinal Office action, mailed May 8, 2007, which set a three-month shortened statutory period for reply. No extensions of time under the provisions of 37 CFR 1.136(a) were obtained. Accordingly, the application became abandoned on August 9, 2007. On November 23, 2007, the Office mailed a Notice of Abandonment.

On petition, applicant asserted that the delay in replying to the nonfinal Office action was unavoidable due to a clerical error in failing to download the Office action in response to the e-mail notification by the USPTO. Specifically, applicant explained:

On May 8, 2007, the PTO notified Applicant's representative of three (3) pieces of PTO Correspondence via e-mail. (Redacted copy enclosed.) Applicant's representative's docketing staff downloaded two (2) of the three (3) pieces of PTO Correspondence, but, due to an error on the part of a docketing staff member in the performance of this clerical function, the

docketing staff failed to download the Office Action for the above-captioned patent application. According to the Transaction History from PAIR (copy enclosed), the PTO did not mail a postcard reminder to Applicant's representative. When such postcard reminders are received, Applicant's representatives docketing staff download or confirm that they have downloaded the PTO Correspondence and make and initial an annotation on the postcard reminder confirming the action taken. Applicant's representative does not have a postcard reminder relating to the Office Action for the above-captioned patent application or any indication that Applicant's representative received such a postcard reminder. Because the docketing staff failed to download the Office Action in response to the initial notification, and, in the absence of a postcard reminder, the docketing staff did not enter the deadlines for responding to the Office Action in Applicant's representative's computer docketing system (copy enclosed) or on a back-up docketing calendar. According to the Transaction History from PAIR, the PTO notified Applicant's representative of the Notice of Abandonment on November 23, 2007 (copy enclosed).

After Applicant's representative downloaded the Notice of Abandonment on November 23, 2007, it immediately located and downloaded the missed Office Action. Applicant's representative analyzed the Office Action and the cited references, and reported the Office Action on January 4, 2008. Applicant's representative received instructions to reply to the Office Action and to file a petition for revival of the application. Thus, despite the Christmas holidays and the complexity of the Office Action, Applicant's representative has prepared and filed a petition for revival of the application and a reply to the Office Action within two (2) months of receipt of the Notice of Abandonment. Therefore, Applicant's representative acted diligently upon receiving the Notice of Abandonment, and Applicant maintains that the entire delay in the filing of the reply from the due date of the reply until the filing of a grantable petition pursuant to 37 C.F.R. § 1.137(a), was unavoidable.

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(l);
- (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant 37 CFR 1.137(d).

The present petition lacks item (3).

The Director may revive an abandoned application if the delay in responding to the relevant outstanding Office requirement is shown to the satisfaction of the Director to be "unavoidable."

35 U.S.C. § 133. Decisions on reviving abandoned applications on the basis of “unavoidable” delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word ‘unavoidable’ . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present. In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Ex parte Pratt, 1887 Dec. Comm’r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 167-68 (D.D.C. 1963), aff’d, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm’r Pat. 139, 141 (1913). In addition, decisions on revival are made on a “case-by-case basis, taking all the facts and circumstances into account.” Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was “unavoidable.” Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

The showing of record is inadequate to establish unavoidable delay within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). Specifically, an application is “unavoidably” abandoned where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, facsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm’r Pat. 31 (Comm’r Pat. 1887).

A delay resulting from an error (e.g., a docketing error) on the part of an employee in the performance of a clerical function may provide the basis for a showing of “unavoidable” delay, provided it is shown that: (1) the error was the cause of the delay at issue; (2) there was in place a business routine for performing the clerical function that could reasonably be relied upon to avoid errors in its performance; (3) and the employee was sufficiently trained and experienced with regard to the function and routine for its performance that reliance upon such employee represented the exercise of due care. See MPEP 711.03(c)(III)(C)(2).

An adequate showing requires statements by all persons with direct knowledge of the circumstances surrounding the delay, setting forth the facts as they know them. An applicant must supply a thorough explanation of the docketing and call-up system in use and must identify the types of records kept and the person responsible for the maintenance of the system. This showing must include copies of mail ledgers, docket sheets, file-wrappers and such other records as may exist which would substantiate an error in docketing, and include an indication as to why the system failed in this instance to provide adequate notice that a reply was due. An applicant must also supply information regarding the training provided to the personnel responsible for the docketing error, degree of supervision of their work,

In the present petition, applicant averred that the clerical error in failing to download the nonfinal Office action in response to the e-mail notification caused the delay at issue and that the firm had a business routine in place for performing the clerical function that could reasonably be relied upon to avoid such clerical errors. Applicant asserted that their legal representatives and the firm's docketing staff were sufficiently trained and experienced in the performance of the USPTO's electronic filing and monitoring procedures that reliance upon these employees represented the exercise of due care. Additionally, applicant indicated that each member of the docketing staff had in-house training on docketing procedures. Applicant explained that the staff member in charge of the docketing staff has more than eight (8) years of experience with the law firm as a patent secretary and a docketing staff member.

If applicant cannot provide the evidence necessary to establish unavoidable delay, applicant may file a petition pursuant to 37 CFR 1.137(b) on the basis of unintentional delay. A grantable petition pursuant to 37 CFR 1.137(b) must be accompanied by:

- (1) The required reply (unless previously submitted);
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition was unintentional. The Director may require additional information where there is a question whether the delay was unintentional.
- (4) Any terminal disclaimer (and fee set forth in § 1.20(d)) required pursuant 37 CFR 1.137(d).

By mail:


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Attn: Office of Petitions

By hand: Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be submitted via the Electronic Filing System of the USPTO.

Telephone inquiries related to this decision may be directed to the undersigned at (571) 272-3211.

A handwritten signature in cursive script that reads "Christina Tartera Donnell".

Christina Tartera Donnell
Senior Petitions Attorney
Office of Petitions